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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,696	07/21/2003	Wen-Chieh Wang	WANG3188/EM	4393
23364	7590	11/01/2004	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			PAPE, ZACHARY	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/622,696	<b>Applicant(s)</b> WANG ET AL.	
	<b>Examiner</b> Zachary M. Pape	<b>Art Unit</b> 2835	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7-21-2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the track point must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The use of the trademark TRACKPOINT has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5 & 6 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 5 mentions the use of a "trackpoint" <sup>TM</sup> as a cursor controlling device. The specification lacks proper antecedent basis for this device. Support and clarification of the trackpoint <sup>TM</sup> as a trademark should be provided in the specification.

5. With respect to claim 6, it is unclear what is meant by a "standard 85-key keyboard". Applicant figures show a keyboard 4 in Fig. 2 with 71 keys. The examiner's

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personal "standard" keyboard for example, has 104 keys. Applicant is required to clarify and/or correct both the specification and the claims as to what is meant by a "standard 85-key keyboard".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 5 recites the Trade Mark "TRACKPOINT." This Trade Mark may cause confusion as to the scope of the claims since it cannot be used properly to identify any particular product or material. See MPEP 2173.05(u).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1 – 4, 7 rejected under 35 U.S.C. 102(a) as being anticipated by Lunsford (Patent # 6,507,336).

With respect to claims 1 and 2, Lunsford teaches the use of a shell (110) having a top face (113), a bottom face (116) and four peripheral sides (117, 119, 107, 109)

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within which a user-interactive display (120) is mounted adjacent to a plurality of application buttons (130). Such a user-interactive display in a PALM® device as disclosed here is the use of an LCD screen as an interactive display. Additionally the application buttons (130) are considered by the examiner to be a keyboard. Lunsford further discloses a cover face (Fig 3B,302) coupled adjacent to the display and keyboard and extends to cover the surface of the handheld computer (Column 6, Lines 27-28).

Lunsford also teaches that a plurality of buttons 340 may be incorporated into either the inner surface of the front cover (Column 6, Lines 9-11) or exterior surface (310) of the front cover (302; Column 7, Lines 54-56) as shown in Figs 3A, 340, and Fig 2B, 240. Touching keys 342 of the tappable keyboard mounted on the inside cover inherently moves cursor forward and therefore is a cursor control. Additionally Lunsford teaches the use of a flexible circuit (cable means) (Column 5, Line 15) for transmitting data from cover-mounted devices to the portable computer.

With respect to claim 3, Lunsford discloses a plurality of application buttons (130) mounted on the top end.

With respect to claim 4, Lunsford discloses that a tappable keyboard be incorporated into the inside of the front cover (302). Such a tappable keyboard is inherently a touchpad.

With respect to claim 7, Lunsford discloses in Column 4, Lines 34-44 that such a device include various PALM® organizers or other portable computers. In Fig 1A

Lunsford also illustrates an example of such a device that includes the display and input buttons on the same plane. Such a style is inherent in the design of a tablet PC.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Lunsford in view of Winn L. Rosch Hardware Bible (Rosch).

With respect to claim 6 in so far as the "standard 85-key keyboard" can be understood, the examiner is interpreting this to mean any "standard" alphanumeric keyboard. Lunsford teaches the use of a "standard" keyboard 236 in an alphabetic or Qwerty layout (Col 7, Lines 13-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use either the keyboard of Lunsford or any other "standard" keyboard as an alternate equivalent means of data entry.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lunsford as applied above in view of Rosch. Lunsford fails to disclose a trackpoint <sup>TM</sup> for cursor control. Rosch teaches the conventionality of using a trackpoint <sup>TM</sup>. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the trackpoint <sup>TM</sup> of Rosch in the device of Lunsford. The use of a trackpoint <sup>TM</sup> in Lunsford

would provide the device with a solid state cursor control with no moving parts thus reducing the risk of breaking or damaging the device.

### ***Claim Objections***

11. Claim 5 recites the limitation "TRACKPOINT" in lines 21-22. There is insufficient antecedent basis for this limitation in the claim. The specification fails to identify a trackpoint <sup>TM</sup> as disclosed in claim 5.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary M. Pape whose telephone number is 571-272-2201. The examiner can normally be reached Mon. - Thur. & every other Fri. (8:00am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

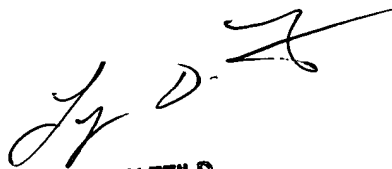


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ZMP



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